

DETAILED ACTION

Period For Seeking Court Review Has Lapsed

The period under 37 CFR **1.304** for seeking court review of the decision by the Board of Patent Appeals and Interferences rendered **July 14, 2012** has expired and no further action has been taken by appellant. The proceedings as to the rejected claims are considered terminated; see **37 CFR 1.197(b)**.

The application will be passed to issue on allowed claims 7, 15 and 23 provided the following formal matters are promptly corrected: **See comments, 101 and double patenting issues below**. Prosecution is otherwise closed.

Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under **37 CFR 1.136**.

Claim Rejections - 35 USC § 101

Claim 15 is rejected under 35 USC 101 since the claims are directed to non-statutory subject matter. Claim 18 recites “computer usable medium” which appears to cover both transitory and non-transitory embodiments. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers

a signal *per se*, the claim **must** be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer **cannot** overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 7, 15 and 23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 7, 15 and 23 of copending

Application No. 13/600201. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Note/comments:

Claim 7 line 7 recites "...so that the processed versions can be ..." Positive recitation of this limitation is required.

Claim 15 line 8 recites "...so that the processed versions can be ..." Positive recitation of this limitation is required.

Claim 23 line 11 recites "...so that the processed versions can be ..." Positive recitation of this limitation is required.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dharia Rupal can be reached on 571-272-3880. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yasin M Barqadle/
Primary Examiner, Art Unit 2456